EXPEDITED PROCEDURE – EXAMINING GROUP 1632

S/N 10/074,896 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Joy Campbell et al.	Examiner: Valarie E. Bertoglio
Serial No.:	10/074,896	Group Art Unit: 1632
Filed:	February 13, 2002	Docket No.: 1828.003US1
Title:	POULTRY FEED SUPPLEMENT FOR INCREASING POULTRY BREAST MEAT WEIGHT	

AMENDMENT & RESPONSE UNDER 37 C.F.R. 1.116

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Responsive to the Final Office Action mailed May 27, 2005 and to the Advisory Action mailed March 6, 2006, reconsideration is respectfully requested in view of the following amendments and remarks.

This response is accompanied by a Petition, as well as the appropriate fee, to obtain a two-month extension of the period for filing the Brief on Appeal, thereby moving the deadline for response from January 21, 2006 to March 21, 2006.

A request for continued examination of the above-identified application under 37 C.F.R. § 1.114 is enclosed herewith.

IN THE CLAIMS

Please amend the claims as follows:

1. (Currently Amended) A method of increasing the yield of breast meat and decreasing the yield of thigh and leg meat from poultry comprising: administering to poultry a supplement comprising spray-dried ~~powdered~~ animal plasma so as to increase the yield of breast meat from the poultry, while decreasing the yield of thigh and leg meat from said poultry.

2. (Previously Presented) A method according to claim 1 whereby the supplement is administered through the poultry's feed.

3. (Previously Presented) A method according to claim 2 whereby the supplement comprises up to 15% by weight of the poultry's feed.

4. (Previously Presented) A method according to claim 1 whereby the supplement is administered through the poultry's water supply.

5. (Previously Presented) A method according to claim 4 whereby the supplement is administered at a concentration of up to about 0.05-3.0% by weight of the poultry's water supply.

6. (Previously Presented) A method according to claim 5 whereby the supplement is administered at a concentration of up to about 0.1-1.5% by weight of the poultry's water supply.

7. (Canceled)

8. (Currently Amended) A method according to claim ~~7~~ 1 whereby the particle size of the animal plasma is at least 50 microns.

9. (Original) A method according to claim 8 whereby the particle size of the animal plasma is less than about 2000 microns.

10. (Previously Presented) A method according to claim 1 wherein the source of the animal plasma is a transgenic animal.

11. (Original) A method according to claim 1 wherein the source of the animal plasma is a livestock animal.

12. (Previously Presented) A method according to claim 1 wherein the source of the animal plasma is poultry, porcine or bovine blood.

13. (Original) A method according to claim 1 whereby the poultry is selected from the group consisting of chickens, turkeys, Cornish hens, pheasants, ducks, and geese.

14. (Previously Presented) A method according to claim 1 wherein the supplement is administered to newly hatched poultry.

15-16. (Canceled)

17. (Previously Presented) A method according to claim 1 wherein the administration of the supplement increases the yield of breast meat by about 6-8% by weight.

18-30. (Canceled)

REMARKS

Claim 1 and 8 having been amended and claims 7 and 29-30 having been canceled, the claims pending in the above-identified application are claims 1-6, 8-14 and 17. The amendments to claim 1 are supported by claims 7 and 29-30, and in the specification at page 3, line 31-page 4, line 2. Preparation and commercial sources of spray-dried animal plasma are disclosed at pages 5-7 of the specification.

In the Office Action mailed May 27, 2005 the Examiner rejected claims 1-4, 7-14, 17 and 29-30 as anticipated by commonly-owned Weaver et al. (U.S. Patent No. 6,004,576). Claim 10 had earlier been rejected as obvious over the '576 patent on the basis that the use of plasma from a transgenic animal does not impart patentability to the method of claim 1. Insofar as this rejection may be maintained with respect to the amended claims, it is respectfully traversed.

The Examiner is respectfully requested to consider that 35 U.S.C. § 100(b) specifically contemplates the claiming of new and unobvious uses of "old" compositions of matter as methods or processes:

> "The term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."

This statute is in harmony with the body of law recognized prior to the enactment of that statute. *In re Ducci*, 225 F.2d 683, 107 USPQ 88 (CCPA 1955).

An invention based upon the discovery of an unobvious use of an old composition must be claimed in a method or process claim, not in a product claim. *In re Moreton*, 288 F.2d 708, 129 USPQ 227 (CCPA 1961); *In re Hack*, 245 F.2d 246, 114 USPQ 161 (CCPA 1957); *Clinical Products Ltd. v. Brenner, Comr. Pats.*, 255 F. Supp. 151, 149 USPQ 475 (DCDC 1966). The Examiner is requested to note the Applicants are not attempting to patent an "old composition" based on their discovery of previously unknown properties.

35 U.S.C. § 100(b) abrogated the principle that a new use of an old process or device was not patentable on that ground alone. *Joseph Bancroft & Sons Co. v. Watson, Comr. Pats.*, 170 F. Supp. 78, 120 USPQ 265 (DCDC 1959); *In re Thuau*, 135 F.2d 344, 57 USPQ 324 (CCPA 1943). However, not every new use is patentable; like other subject matter, it must meet the other requisites of patentability, viz., novelty and unobviousness. *Sun Chemical Corp. et al. v.*

Brenner, Comr. Pats., 267 F. Supp. 617, 154 USPQ 143 (DCDC 1967); *Grinnell Corp. v. Va. Elec. & Power Co. et al.*, 401 F.2d 451, 159 USPQ 9 (CA 4 1968), and cases cited therein. However, the outcome or effect of the application of the "old" composition is an element of the claim, and must be given weight when evaluating patentability.

In the case of the present claims, the use of spray-dried animal plasma to alter the balance of meat types in poultry is a novel and unobvious use of spray-dried animal plasma, which was known to be useful for other purposes. The Weaver patent discloses that "[p]ost-weaning lag (poor appetite, slow growth and diarrhea) is dramatically-reduced when newly-weaned pigs are fed a starter diet supplemented with dried animal plasma. Appetite and weight gain in small, newly-weaned pigs is improved with supplementation of the pig starter [diet] with spray-dried plasma (DAP)." (Col. 2, lines 11-16). Weaver et al. disclose and claim administration of a new form of spray-dried plasma powder, namely "granulated particles" of "at least about 50 microns." As disclosed at Col. 4, lines 42-66, these granules are formed by compressing the spray-dried plasma powder particles into larger "granules." This process is set forth in claim 1, and was found to yield a "granulated animal plasma" that exhibited improved results, particularly when fed to young pigs.

While it is generally disclosed that this material can be fed to "avian" species to "increase weight gain, feed intake and feed efficiency," there is no disclosure in Weaver et al. that would lead one of ordinary skill in the art to administer either of these forms of dry plasma to alter the ratio of the breast meat weight to the weight of the meat of the thighs and legs of poultry. As set forth in the Background, this is a commercially valuable effect, both from the standpoint of consumer health (low fat) and consumer acceptance (more white meat vs. less dark meat).

In re Marshall, 198 USPQ 344 (CCPA 1978), the court reversed a rejection of claims directed to the use of an anesthetic, oxethazaine, to inhibit digestion, and thus to cause weight loss. Oxethazaine had been previously used to treat gastric disorders. The court concluded:

> Nothing in the [cited] PDR remotely suggests taking oxethazaine to lose weight. If anyone ever lost weight by following the PDR teachings it was an unrecognized accident. An accidental or unwilling duplication of an invention cannot constitute an anticipation. *In re Felton*, 484 F.2d 495, 500, 179 USPQ 295, 298 (CCPA 1973).

Likewise, if anyone ever fed spray-dried animal plasma to poultry in amounts and for a sufficient period to alter the ratio of breast meat to leg/thigh meat, it was likewise an "accidental or unwilling duplication" of the claimed invention. Therefore, withdrawal of this rejection is appropriate and is respectfully requested.

At page 6 of the Office Action, the Examiner rejected claims 1-7, 10-11, 13-14 and 17 as obvious over Adalsteinsson et al. (U.S. Patent No. 6,086,878). Insofar as this rejection may be maintained with respect to any of the amended claims, it is respectfully traversed.

Adalsteinsson et al. disclose and claim a method for increasing "muscle proteins" in an animal by administering an effective amount of a composition comprising "a gastrointestinal neuro-modulator antibody." The effective amount is not disclosed to be present in spray-dried animal plasma, but is induced in eggs or milk by hyperimmunizing an egg-producing or milk-producing animal with "an antigenic or genetic vaccine." At Col. 9, lines 13-20, it is disclosed that "[i]t is preferred that administration occur by feeding egg or egg yolk from vaccinated egg-producing animals or milk from vaccinated milk-producing animals." While the '878 patent discloses that "antibodies can be obtained from whole blood, plasma or serum from any inoculated animal," it does not disclose or suggest direct feeding of animal plasma in any form to achieve the desired effect. Also, the expectation of the art worker would be that the Adalsteinsson antibodies would increase "muscle protein" uniformly, not selectively. Thus, Applicants specifically dispute that the '878 patent "teaches the claimed method steps" or that "such method steps would inherently result in the increase in breast meat at the expense of thigh and leg meat in poultry."

In re Shetty, 195 USPQ 753 (CCPA 1997), the court addressed the question of whether or not a new medical use of a compound structurally similar to an "old compound" that was used for a different medical purpose, was obvious. The court reasoned: "That appellant's 'amount effective to curb appetite' corresponds to or inheres in Narayanan's [prior art] amount 'to combat microbial infestation' does not persuade us of the obviousness of appellant's [claimed] method...Prior to appellant's disclosure, none of the adamantane compounds in any of the references before us suggested a use, much less a dosage, for curbing appetite. What we said in *In re Spormann*...relative to inherency applies equally here:

> As we pointed out in *In re Adams*...the inherency of an advantage and its obviousness are entirely different questions. That which is inherent is not necessarily known. Obviousness cannot be predicated on what is unknown!

To summarize, it is Applicants' position that an obviousness rejection of a new use for an old composition based on the inherency of one or more claim elements is legally untenable in the absence of some suggestion in the prior art that those elements are present in the prior art process. Likewise, it is Applicants' position that "inherency" also cannot be used to supply a result that is missing in a prior art process, in order to reject a new use of an old composition as anticipated by prior art uses of that composition, in the absence of any evidence that the art worker would recognize that the new result had occurred, or could result. The Examiner is invited to cite legal authority which establishes that the line of cases discussed above has been reversed by the Federal Circuit. In the absence of such a showing, it is respectfully submitted that withdrawal of these rejections is appropriate, and is respectfully requested.

The Examiner is invited to telephone Applicant's attorney at (612) 373-6903 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JOY CAMPBELL ET AL.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of March, 2006.

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